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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/972,076	10/05/2001	Gregory A. Johnson	35006-629001US	4558
76615 7590 05/27/2010 MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C ONE FINANCIAL CENTER BOSTON, MA 02111				
EXAMINER RUTTEN, JAMES D				
ART UNIT		PAPER NUMBER		
2192				
MAIL DATE		DELIVERY MODE		
05/27/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Advisory Action  
Before the Filing of an Appeal Brief**

**Application No.**

09/972,076

**Applicant(s)**

JOHNSON ET AL.

**Examiner**

JAMES RUTTEN

**Art Unit**

2192

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 12 May 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 84-106.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_  
13. ☐ Other: \_\_\_\_\_.

/J. Derek Rutten/  
Primary Examiner, Art Unit 2192

Continuation of 3. NOTE: The amendments of claims 84 and 105 change the scope of the claims and would require further consideration and/or search. Therefore, the amendment is not entered (see MPEP 714.20).

Continuation of 11. does NOT place the application in condition for allowance because:

On page 9 filed 5/12/2010, Applicant argues with respect to claim 84, that Fig. 1 provides written description support under 35 U.S.C. § 112, first paragraph. In particular, Applicant notes the bi-directional arrows and the phrase "results returned." However, the issue does not regard a written description of "results returned." Applicant fails to address the basis of the rejection which is that there does not appear to be a description of the remote server (i.e. "code generator 104") returning the output of the decision service (i.e. "decision server 109") to the client server (i.e. "web server 111"). The rejection of claim 84 under 35 U.S.C. § 112, first paragraph is maintained.

In regard to the rejection of claim 104 under 35 U.S.C. § 112, first paragraph, Applicant points to p. 21, line 12, p. 22, lines 15-16, and Figs. 15-17 for additional support. However, none of these citations provide any written description to match the scope of claim 104. It is noted that none of these cited portions even mention a "decision tree," much less a description of the extensive utilization of such "decision trees" found in claim 104. The rejection is maintained.

The rejections under 35 U.S.C. § 112, second paragraph, are maintained since the claim amendments have not been entered.

On pages 11-12, Applicant argues that interpretation of the claimed "decision server" is overly broad, and that "business rules in a business layer" cannot read on the claims in view of the specification. Applicant is correct in suggesting that claims must be interpreted in light of the specification. However, reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is a quite different thing from "reading limitations of the specification into a claim," to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim. It is not clear what characteristics Applicant is suggesting such a "decision server" to have. Prior art of record Courts (US 6085220) discloses business rules to assist in making "complicated decisions" (see column 3 lines 49-53). It is not clear why a server that assists in making decisions cannot be regarded as a "decision server." The rejections are maintained.

In the middle of page 12, Applicant notes the citation of Courts col. 8 lines 18-41. Presumably, this is in reference to the rejection of claim 84 on page 9 of the 3/12/2010 Office action. This particular section introduces an obviousness analysis of Courts, which is subsequently followed by the additional teaching of Mears (US 6041362) which further teaches remote and client servers. Again, it is not clear which characteristics are intended to be covered such that an interpretation of remote and client servers cannot be interpreted according to a reading of remote and client servers, at least as taught by Mears, let alone Courts. The rejection is maintained.

At the bottom of page 12, Applicant essentially argues that Courts and APAA does not teach all the limitations of claim 104. However, the rejection is based upon a combination of references including prior art of record Mears, and not Courts and APAA alone. For at least this reason, Applicant's argument is not persuasive. The references combine to teach an obvious arrangement of data exchange and display.

In response to applicant's argument on page 13, that the examiner has combined an excessive number of references, reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

In response to applicant's argument that Courts, Mears, Cluts, Meltzer, Traversant and Ho are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Applicant appears to acknowledge that each of the references at least "skirt around the claimed subject matter" (see top of page 14 filed 5/12/2010). As such, the references are considered to be at least "reasonably pertinent" to the problems at hand.